

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE M. D'ANDRADE

Appeal No. 1999-1235
Reexamination Control No. 90/004,477¹

HEARD: September 15, 1999

Before CALVERT, Administrative Patent Judge and McCANDLISH,
Senior Administrative Patent Judge and BAHR, Administrative
Patent Judge.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of claims 1 through 3, 7 through 13 and 17 through

¹ Request filed December 5, 1996 by Alan B. Amron for the reexamination of U.S. Pat. No. 5,339,987, issued August 23, 1994, based on Application No. 08/082,735, filed June 28, 1993.

19. The examiner has found the subject matter recited in claims 4 through 6, 14 through 16 and 20, the only other claims pending in this proceeding, patentable. No amendments have been made to the claims during this proceeding.

BACKGROUND

The appellant's invention relates to a water gun. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.²

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Greene	2,249,608	Jul. 15, 1941
D'Andrade et al. (D'Andrade)	5,074,437	Dec. 24, 1991

The following rejections are before us for review.

Claims 1 to 3 and 11 to 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Greene.

² The copies of claims 1 and 11 in the appendix contain minor errors relative to the actual claims on appeal. In claim 1, line 17, "to" has been omitted after "position." In claim 11, line 2, "at least one air/water storage tank," has been omitted before "a."

Claims 7 to 10 and 17 to 19 stand rejected under 35
U.S.C.

§ 103 as being unpatentable over Greene in view of D'Andrade.

Reference is made to the brief (Paper No. 13) and the
answer (Paper No. 18) for the respective positions of the
appellant and
the examiner with regard to these rejections.³

OPINION

On page 4 of the brief, the appellant states that "claims
1-3 are grouped together, claims 7-13 are grouped together and
claims 17-19 are grouped together." However, as the brief
(pages 4 to 10) argues claims 1 to 3 and 11 to 13 together as
a group and claims 7 to 10 and 17 to 19 together as a group,

³ After carefully reviewing the reexamination file for this proceeding, we can find no evidence that the appellant has served copies of any of the papers filed by the appellant in this proceeding on the third party requestor or that a copy of the examiner's answer was sent to the requestor, as required by 37 CFR § 1.550(e). We remind the appellant and the examiner of the requirement in 37 CFR § 1.550(e) that the PTO send copies of all Office actions to the requestor and that the appellant serve on the requestor copies of all documents filed in a reexamination proceeding. See Section 2266.03 of the Manual of Patent Examining Procedure. In light thereof, we urge the appellant to immediately serve on the requestor copies of all documents filed by the appellant in this proceeding, including, *inter alia*, the appeal brief (Paper No. 13) filed November 7, 1997, unless this has already been done, and to file in the PTO certificates of service of each of these documents. Further, we encourage the examiner to ensure that a copy of the examiner's answer has been sent to the requestor.

we presume the appellant's stated grouping to be in error. Thus, in accordance with 37 CFR 1.192(c)(7), we have selected claim 1 as the representative claim to decide the appeal of the rejection of claims 1 to 3 and 11 to 13 and claim 7 as the representative claim to decide the appeal of the rejection of claims 7 to 10 and 17 to 19.

Turning first to the 35 U.S.C. § 102(b) rejection, Greene discloses a water⁴ gun comprising a housing forming a handle member (6) and two tubular members or tanks (1,2), a barrel (nozzle 16), a pressurizing mechanism (gas cartridge 8) for pressurizing the tubular members, a release channel formed by opening (18) and passageway (19) and a release mechanism including a valve with valve stem (23a) located in the passageway, a first compression spring (27) biasing the valve stem to its normal, closed position (page 2, left column, lines 33 to 39), a trigger (56) connected to the housing at supporting member (55), as shown in Figure 5, and a linkage (bars 51 and 53) connected to the trigger and the valve stem. The trigger is biased in a forward position by a tension

⁴ Note page 1, left column, lines 26 to 33, regarding the use of water in the disclosed gun.

spring (59), whose tension must be overcome to pull the trigger to move the valve stem to its open position (page 2, last paragraph). A tension spring (61) is fastened at one end to the bars (51) and at the other end to the lower portion of the trigger "so that the bars 51 will normally remain in such a position that the pivotal point 54 will be below a horizontal plane passing through the pivotal point 52" (page 3, left column, lines 1 to 6).

The operation of the trigger to release fluid from the nozzle is discussed on page 3, left column, lines 49 to 72, as follows:

The operation of the modification in Fig. 5 is such that when the trigger 56 is pulled, the valve stem 23a will be moved rearwardly opening the nozzle for ejection of the fluid. As the trigger 56 is moved rearwardly the pivotal point 54 will also move rearwardly and upwardly describing an arc so that the pivotal points 54, 58 and 52 will be in direct alinement with each other. Immediately upon the pivotal point 54 moving above the plane wherein the three points are in alinement, which is the dead center point of the mechanism, the spring 27 will draw the valve stem forwardly and the pivotal point 54 will move forwardly sufficient to close the nozzle, resulting in a toggle action of the bars 51 and 53. The nozzle, then, will have been automatically closed even though the trigger remains in a rearward position. Upon releasing the trigger 56, the tension spring 61 will draw the bars 51 downwardly so that they, together with the bar 53,

will assume their normal position once again as shown in Fig. 5 and the spring 59 will urge the trigger forwardly.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellant argues on page 7 of the brief that Greene does not anticipate claim 1 because:

In summary, there is no teaching or suggestion in Greene of a controlled flow, bursting water gun release mechanism which does not require means for automatically releasing the valve retracting means. Moreover, Greene does not teach that the flow from such a mechanism can be controlled by the distance of the retraction of the trigger.

We do not find this argument persuasive. It is well settled that the particular feature or fact upon which an applicant

predicates patentability must not only be disclosed in the specification but also brought out in the claims. See In re Richards, 187 F.2d 643, 645, 89 USPQ 64, 66 (CCPA 1951). We find nothing in the claim which either precludes "means for automatically releasing the valve retracting means" or requires that the flow be controllable by the distance of the retraction of the trigger. Moreover, with regard to the claim limitation that "release of said trigger permits said first spring to bias said valve back to its first closed position," we note that the trigger of Greene may be released by the operator at the "dead center point" discussed above, thereby permitting the tension spring (61) to draw the bars (51) downwardly whereupon the spring (27) biases the valve stem to the closed position.

Although we find that the tension spring (59) relied upon by the examiner as the "delay spring" recited in claim 1 is not "located on said linkage" as required by the claim, we note that the tension spring (61) is located on the linkage, functions as part of the linkage, and exerts a compressive force that must be overcome before the trigger (56) and bars (51,53) may be moved so the valve will open.

For the foregoing reasons, we find that Greene does anticipate claim 1. Accordingly, we shall sustain the examiner's rejection of claim 1, and claims 2, 3 and 11 through 13 which stand or fall therewith.

Turning now to the rejection under 35 U.S.C. § 103, the examiner concedes that Greene lacks the manual pressurizing pump with a pressure release valve required by claim 7 but argues that it would have been obvious, in view of the teachings of D'Andrade, to substitute the manual pump with the pressure release valve of D'Andrade for the gas cartridge pressurizer of Greene "as the manual pump would require no replacement cartridges and would therefore be useable at all times" and as the pressure release valve would prevent over-pressurization, thereby increasing safety (answer, page 3).

The appellant argues that "[n]o motivation exists to combine the references and the combination of references destroys the intended use of each" (brief, page 8). The appellant contends, in effect, that, because the Greene release mechanism includes a means for automatically releasing the valve when the trigger is fully depressed while the objective of the D'Andrade gun is "to produce a stream of

water that is maintained as long as the trigger is retracted," one of ordinary skill in the art would not have combined the two references to achieve the claimed invention (brief, page 9).

These arguments appear to be directed to a modification of the release mechanism of Greene by substituting a release mechanism as disclosed by D'Andrade which will not automatically close the valve upon full depression of the trigger and not to the modification proposed by the examiner. Rather, the examiner has proposed modifying the pressurizing means of the Greene gun to replace the gas cartridge with a manual pump and a pressure release valve. Thus, to the extent that these arguments are directed to the nonobviousness of a modification of the release mechanism, they are not pertinent to the rejection at issue.

To the extent that these arguments are directed to the modification of the pressurizing means proposed by the examiner, we do not find them persuasive. Regardless of the particular release mechanisms disclosed in each, Greene and D'Andrade both disclose water guns wherein the stored water is pressurized so that it will burst from the barrel upon opening

of a release valve therein. We find nothing in the teachings of either Greene or D'Andrade which would suggest that the modification of the Greene pressurizing means to provide a manual pump and pressure release valve would destroy the operation of either apparatus. On the contrary, we agree with the examiner that the combined teachings of Greene and D'Andrade would have suggested replacement of the pressurizing cartridge of Greene with a manual pump and pressure release valve for the above-noted reasons advanced by the examiner on page 3 of the answer.

Thus, we shall also sustain the examiner's rejection of claim 7, and claims 8 to 10 and 17 to 19 which stand or fall therewith.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 11 to 13 under 35 U.S.C. § 102(b) and claims 7 to 10 and 17 to 19 under 35 U.S.C. § 103 is affirmed. However, since our basis for affirming the examiner's 35 U.S.C. § 102 rejection differs from the rationale of the examiner, we designate the affirmance of the 35 U.S.C. § 102 rejection as a new ground of rejection under 37 CFR § 1.196(b)

in order to provide the appellant with a fair opportunity to respond thereto. See In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426-27 (CCPA 1976). We also designate the affirmance of the 35 U.S.C. § 103 rejection as a new ground of rejection under 37 CFR § 1.196(b) in view of our findings regarding the Greene reference.

37 CFR § 1.196(b) provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
HARRISON E. McCANDLISH, Senior)	
APPEALS)	
Administrative Patent Judge)	AND
)	INTERFERENCES
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